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Atty. Dkt. No. YOR920010137US1

**REMARKS**

In view of the following discussion, the Applicants submit that none of the claims now pending in the application are anticipated under the provisions of 35 U.S.C. §102 or obvious under the provisions of 35 U.S.C. §103. Thus, the Applicants believe that all of the presented claims are in condition for allowance.

**I. REJECTION OF CLAIMS 1, 3-20, AND 22-34 UNDER 35 U.S.C. § 102**

The Examiner rejected claims 1, 3-20, and 22-34 as being anticipated under 35 U.S.C. §102(e) by the Donahue patent (United States Patent No. 7,024,397, issued April 4, 2006, hereinafter "Donahue"). In response, the Applicants have amended independent claims 1, 8, 12, 15, 28, and 31 from which claims 3-7, 9-11, 13-14, 16-20, 22-27, 29, and 32 depend, as well as independent claims 30, 33, and 34, in order to more clearly recite aspects of the present invention.

Primarily, the Applicants respectfully submit that Donahue fails to teach, show, or suggest the novel invention of allowing negotiating parties to pre-negotiate a meta contract (i.e., a template or contract starting state) that controls the negotiation in accordance with an electronic document provided by one of the negotiating parties prior to the negotiation, as recited in Applicants' independent claims 1, 8, 12, 15, 28, 30, 31, 33, and 34.

By contrast, Donahue teaches a system in which parties negotiating a lease of real estate generate a lease contract via "a series of predefined milestone negotiation steps" (See, Donahue, Abstract, emphasis added). That is, although the parties are free to define certain variable parameters of the lease (e.g., condition of premises, monthly rent, etc.) the parties have no control over the form of the negotiation. Rather, the parties are prompted to indicate agreement with a plurality of provisions that have been defined for them.

The Applicants' claims clearly recite a method and system in which the negotiating parties can control (via pre-negotiation) the form of a meta contract controlling the negotiation, for instance by providing an electronic document on which the meta contract is based. The system taught by Donahue simply does not provide this level of user control over the negotiation process. For instance, Donahue teaches

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that the negotiation process is controlled by "a structured transaction engine [that] controls the negotiation process by displaying web pages containing predefined choices for various aspects of the transaction within each negotiation phase ..." (See, Donahue, column 4, lines 16-21, emphasis added). Moreover, the portion of Donahue that the Examiner cites to teach the limitation of forming a meta contract based in part on information provided by a negotiating party in an electronic document at most teaches that, for each provision of the lease, the negotiating parties may select from among a set of predefined choices provided by the system (See, e.g., Donahue at column 11, lines 47-49: "FIG. 13 shows a web-based computer screen in which a tenant and landlord select predefined choices for lease provisions ...", emphasis added). Thus, Donahue's system provides a fairly rigid negotiation framework in which the negotiating parties have little or no control over the form of the negotiation.

Applicants' claims 1, 8, 12, 15, 28, 30, 31, 33, and 34 positively recite:

1. A method for automating contract negotiation between a plurality of parties, each of the plurality of parties having at least one computing system coupled to a communications network and one or more applications running thereon, the method comprising the steps of:

establishing a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the plurality of parties prior to the contract negotiation;

conducting a pre-negotiation between the plurality of parties to form a negotiation meta contract to control the contract negotiation, in accordance with the negotiation protocol, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation;

communicating a request to negotiate; and

conducting an automatic negotiation, according to the negotiation meta contract, between the one or more applications of each of the plurality of parties. (Emphasis added)

8. A method for conducting a negotiation between a plurality of parties, each of said parties having a computer system coupled to a communication network and one or more applications running thereon, the method comprising the steps of:

providing a specification of machine-executable rules of negotiation for the parties for generating at least one contract, the specification being agreed upon by the plurality of parties prior to conducting the negotiation; and

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conducting a pre-negotiation between the plurality of parties to form a starting state for a contract in accordance with the specification, wherein the starting state is formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation, the at least one electronic document being selectable from one of: a previous contract, a publicly defined template, and a template defined prior to the negotiation by one of the parties. (Emphasis added)

12. A method for conducting an automatic negotiation between a plurality of parties, each of said parties having a computer system coupled to a communication network and one or more applications running thereon, the method comprising the steps of:

establishing a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the plurality of parties prior to the negotiation;

conducting a pre-negotiation between the plurality of parties to form a template prior to the negotiation in accordance with the negotiation protocol, wherein the template is formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation, wherein the template contains business logic for performing a negotiation electronically;

registering the business logic, prior to the negotiation, with a server accessible by one or more parties; and

implementing the business logic in a negotiation conducted automatically between computer systems over the communication network. (Emphasis added)

15. A method for conducting a negotiation between a plurality of parties, each of said parties having a server coupled to a communication network and one or more applications running thereon, comprising the steps of:

providing a specification of machine-executable rules of negotiation for the parties for generating at least one contract, the specification being agreed upon by the plurality of parties prior to conducting the negotiation;

enabling an automatic negotiation to take place between the servers in accordance with the specification of machine-executable rules; and

conducting a pre-negotiation between the plurality of parties to form a meta contract for controlling a negotiation process in accordance with the specification, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation. (Emphasis added)

28. A method for conducting a negotiation between a plurality of parties, each

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of said parties having a computer system coupled to a communication network and one or more applications running thereon, comprising the steps of:

providing a specification of machine-executable rules of negotiation for the parties for generating at least one contract, the specification being agreed upon by the plurality of parties prior to conducting the negotiation;

conducting a pre-negotiation between the plurality of parties to form a meta contract to control the negotiation, in accordance with the specification, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation; and

enabling an automatic negotiation to take place between the parties in accordance with the specification of machine-executable rules;

wherein at least one of the negotiating parties is an intermediary for facilitating the automatic negotiation. (Emphasis added)

30. A computer program product in a computer readable medium in a first computer system for conducting a negotiation between a plurality of parties, comprising:

first instructions for conducting a pre-negotiation between the plurality of parties to form a specification of machine-executable rules of negotiation for the parties for generating at least one contract, the specification being agreed upon by the plurality of parties prior to conducting the negotiation, wherein the specification is formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation;

second instructions for enabling an automatic negotiation to take place between a party located at the first computer system and a party located at a second computer system in accordance with the specification of machine-executable rules; and

third instructions for negotiating a contract automatically between the parties. (Emphasis added)

31. A method of conducting a negotiation over a data communication network between a service provider and a service requester, comprising the steps of:

establishing, by the service provider and the service requester, a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the service provider and the service requester prior to the contract negotiation;

conducting a pre-negotiation between the service provider and the service requester to form a negotiation meta-contract to control the negotiation, in accordance with the negotiation protocol, wherein the meta contract is formed at least in part from information provided by at least one of the service provider and the service requester in at least one electronic document, prior to the negotiation;

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receiving, at the service provider, a request to negotiate from the service requester;

responsive to the request to negotiate, automatically negotiating with the service requester by the service provider in accordance with the negotiation meta-contract. (Emphasis added)

33. A method of conducting business over the Internet, wherein parties negotiate contractual terms between two data communication network components, the method comprising the steps of:

providing a specification of machine-executable rules of negotiation for generating at least one contract, the specification being agreed upon by the parties prior to negotiating the contractual terms;

conducting a pre-negotiation between the parties to form a meta contract to control the negotiating, in accordance with the specification, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation; and

originating a negotiation at a first party in accordance with the rules of negotiation. (Emphasis added)

34. An article of manufacture for automating contract negotiation between a plurality of parties, comprising a machine readable medium containing one or more programs which when executed implement the steps of:

communicating, in a preliminary step, a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the plurality of parties prior to the contract negotiation;

conducting a pre-negotiation between the plurality of parties to form a negotiation meta contract to control the contract negotiation, in accordance with the negotiation protocol, wherein the meta contract is formed at least in part from information provided by at least one party in at least one electronic document, prior to the negotiation;

communicating a request to negotiate; and

conducting an automatic negotiation, according to the negotiation protocol, between the one or more applications of each of the plurality of parties. (Emphasis added)

Since Donahue does not teach or suggest allowing negotiating parties to pre-negotiate a meta contract (i.e., a template or contract starting state) that controls the negotiation in accordance with an electronic document provided by one of the negotiating parties prior to the negotiation, Donahue does not teach each and every element of Applicants' amended independent claims 1, 8, 12, 15, 28, 30, 31, 33, and 34.

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Moreover, dependent claims 3-7, 9-11, 13-14, 16-20, 22-27, 29, and 32 depend, either directly or indirectly, from independent claims 1, 8, 12, 15, 28, and 31 and recite additional features. As such, and for at least the exact same reason set forth above, the Applicants submit that claims 3-7, 9-11, 13-14, 16-20, 22-27, 29, and 32 are also not anticipated and are allowable.

Therefore, Applicants contend that claims 1, 3-20, and 22-34 are patentable over Donahue and, as such, fully satisfy the requirements of 35 U.S.C. §102. Thus, Applicants respectfully request that the rejection of claims 1, 3-20, and 22-34 under 35 U.S.C. §102 be withdrawn.

## **II. REJECTION OF CLAIM 21 UNDER 35 U.S.C. § 103**

The Examiner rejected claim 21 as being unpatentable under 35 U.S.C. §103(a) over Donahue. The Applicants respectfully traverse the rejection.

As discussed above, Donahue fails to teach or suggest the novel invention of allowing negotiating parties to pre-negotiate a meta contract (i.e., a template or contract starting state) that controls the negotiation in accordance with an electronic document provided by one of the negotiating parties prior to the negotiation, as recited in Applicants' amended independent claim 15.

Dependent claim 21 depends from independent claim 15 and recites additional features. As such, and for at least the exact same reason set forth above, the Applicants submit that claim 21 is also not made obvious and is allowable. Therefore, Applicants contend that claim 21 is patentable over Donahue and, as such, fully satisfies the requirements of 35 U.S.C. §103. Thus, Applicants respectfully request that the rejection of claim 21 under 35 U.S.C. §103 be withdrawn.

## **III. CONCLUSION**

Thus, the Applicants submit that all of the presented claims fully satisfy the requirements of 35 U.S.C. §102 and 35 U.S.C. §103. Consequently, the Applicants believe that all of these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

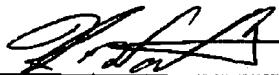
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If, however, the Examiner believes that there are any unresolved issues requiring the issuance of a final action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Kin-Wah Tong, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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